

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

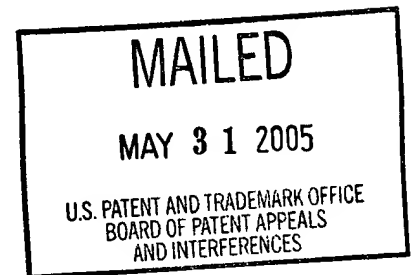
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte KLAUS-JUERGEN PEES, GUENTER KRUMMEL,
HENRY VAN TUYL COTTER, GUIDO ALBERT, ANNEROSE REHNIG,
LESLIE MAY and WALDEMAR PFRENGLE

Appeal No. 2005-0977
Application No. 09/840,488

ON BRIEF



Before ELLIS, SCHEINER and ADAMS, Administrative Patent Judges.

SCHEINER, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-9, reproduced in Appendix I of appellants' Brief on Appeal, filed March 22, 2004.

The reference relied on by the examiner is:

Pfengle

5,981,534

Nov. 9, 1999

Claims 1-9 stand rejected under 35 U.S.C. § 102(e) as anticipated by Pfengle. In addition, claim 9 stands rejected under the first paragraph of 35 U.S.C. § 112, as lacking enablement.

We affirm the anticipation rejection, and do not reach the enablement rejection.

DISCUSSION

Claims 1-9 stand rejected under 35 U.S.C. § 102(e) as anticipated by Pfrengle. Appellants do not dispute that Pfrengle describes the claimed fungicidal compounds, but assert that “the present application is entitled to an effective filing date which is prior to the earliest U.S. filing date of Pfrengle” (Brief, page 4).

As explained by the examiner, “to antedate the [Pfrengle] reference, appellants need [the] benefit of [PCT/US/98/05615,] which was not mentioned in the parent [application no. 09/272,916, filed March 19, 1999, now U.S. Patent No. 6,255,309]” (Answer, page 3). Appellants indicate that they “have submitted an application to reissue U.S. Patent No. 6,255,309 which . . . aims to correct the claim to priority in the parent case to include a claim to the priority of PCT/US98/05615, filed on March 23, 1998” (Brief, page 4). According to appellants, with “the corrected claim to priority, the present application is entitled to an effective filing date which is prior to the earliest U.S. filing date of Pfrengle, and the teaching of Pfrengle is no longer applicable under Section 102(e)” (id.).

While we note appellants’ request in the Brief that the issue of anticipation be held in abeyance pending resolution of the application to reissue U.S. Patent No. 6,255,309 (Brief, page 4), we also note that no petition for suspension of action (e.g., under 37 CFR § 1.103) has been submitted in the instant application. As matters now stand, Patent No. 6,255,309 has not been reissued; Pfrengle’s filing date (September 25, 1998) still antedates the effective filing date of the instant application (March 19, 1999); prosecution in both cases is ongoing; and the examiner’s rejection in the instant application is before us for review. Therefore, we will proceed to a decision on the merits.

It is undisputed that Pfrengle describes the claimed subject matter. Inasmuch as Pfrengle is presently available as prior art under 35 U.S.C. § 102(e), the rejection of claims 1-9 as anticipated by Pfrengle is affirmed.

OTHER ISSUE


Our affirmance of the rejection under 35 U.S.C. § 102(e) constitutes a disposition of all the claims on appeal, therefore we need not reach the rejection of claim 9 under the first paragraph of 35 U.S.C. § 112. However, in the event of further prosecution in this application, we would encourage appellants and the examiner to resolve what appears to be a simple factual issue - either Zn^{+1} can be used in the claimed method, or as the examiner asserts (Answer, page 4), it cannot. Appellants have argued, on the one hand, that "the valence state of the metal has no impact on the transmetallation reaction" (Brief, page 6), and on the other hand, that "a reasonable person of ordinary skill . . . would not attempt to produce a compound (III) wherein M represents Zn in the valence state +1" (*id.*, page 5). These seemingly contradictory arguments do nothing to dispose of the issue.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136 (a).

AFFIRMED


Joan Ellis
Administrative Patent Judge


Toni R. Scheiner
Administrative Patent Judge


Donald E. Adams
Administrative Patent Judge

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